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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/597,531

07/28/2006

Thomas Portele

DE040033

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24737 7590 10/02/2008  
PHILIPS INTELLECTUAL PROPERTY & STANDARDS  
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EXAMINER

UBER, NATHAN C

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

10/02/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/597,531	<b>Applicant(s)</b> PORTELE ET AL.	
	<b>Examiner</b> NATHAN C. UBER	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### Status of Claims

1. This action is in reply to the national stage entry application filed on 28 July 2006.
2. Claims 1-16 are currently pending and have been examined.

### Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 7, 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim elements "means for receiving" and "means for transmitting" of **claim 7** are means (or step) plus function limitations that invoke 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. Because the specification does not explicitly discuss the *means for receiving* or the *means for transmitting*, one of ordinary skill in the art is not apprised of what Applicants is claiming. Here, the *means for receiving* is particularly vague and indefinite because of the various applicable definitions and contexts that the language inspires. For example *means for receiving* could invoke the context of receiving data via digital equipment, or it could mean simply being awarded bonus points. Likewise *means for transmitting* points to a server, without sufficient disclosure in the specification, leaves one of ordinary skill in the art to contemplate the myriad of ways information may be "transmitted" to a server including by manual data entry.
5. The claim element "determining the location" of **claim 10** is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. Applicant merely suggests a GPS device as an example of a locating means. The phrase "such as a GPS system"

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(see at least pp. 3 line 17 of the specification) is repeated throughout the specification. Simply providing an example of a device does not particularly and distinctly point out to one having ordinary skill in the art the nature and scope the invention.

6. The claim element "determining the time" of **claim 11** is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. Applicant simply fails to describe what structural element is accomplishing this function. The claim is indefinite because there are many ways for a device to determine time ranging from actually incorporating a time keeping device (which itself had a myriad of structural and digital varieties) to querying other devices or networks to determine time (this option also may be accomplished by a dizzying array of different structural elements).
7. Applicant is required to:
  - (a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
  - (b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).
8. If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:
  - (a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

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(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function.

For more information, see 37 CFR 1.75(d) and MPEP 2181 and 608.01(0).

9. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is indefinite because it is not clear where the preamble of the claim terminates and the body of the claim begins. Usually a claim contains three basic elements, a preamble, a transition phrase, and a body which includes usually a list of limitations. Claim 16, however, contains 3 transition phrases. In its current form, the claim is for a system containing at least a collector device which itself contains at least a manager server. Examiner interprets Applicant's intention was to claim a system comprising a collector device and a manager server and further limit each of those components.

#### **Claim Rejections - 35 USC § 101**

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 is directed to a method which is a statutory class of invention; however the claim contains a judicial exception and does not disclose a practical application to the judicial exception. Judicial exceptions are types of methods that are not statutory without a practical application. Here the method of claim 1 is directed to an abstract idea *collecting and managing bonus points*. In order for this abstract idea to be statutory under 35 U.S.C. 101, there must be a practical application which includes either a physical transformation or a useful, concrete and tangible result. There is not a physical transformation disclosed in the claim, and further there does not appear to be a useful concrete or tangible result in the claim. The preamble of the claim states that the invention is a "method of collecting and managing bonus points in

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order to generate a personal profile based on said points.” The limitations only mention transmitting at least one bonus point and receiving and storing the transmitted point. The claims do not expressly lay out steps to achieve the result suggested in the preamble: collecting points, managing the points, and generating a profile. At best, the only result mentioned is receiving the transmission. This result lacks utility because the result is not specific. Further this result is not concrete because it is not predictable and repeatable. Finally the result is not tangible because the result is not a real-world result, it persists in abstraction.

### **Claim Rejections - 35 USC § 102**

- 12.** The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 13. Examiner’s Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.
- 14.** Claims 1 and 5-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Albanese (U.S. 2004/0111360 A1).

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**Claim 1:**

Albanese, as shown, discloses the following limitations:

- *transmitting at least one bonus point from a collecting device comprising information relating to specific activity performed by the person together with an identification of said person* (see at least ¶0070, device readers 102 and 106 are capable of information from any portable information device containing profile information, see also at least ¶0059, information transmitted; Examiner notes that Albanese discloses transmitting points as well as a variety of other data, Examiner further notes that Applicant has attempted to distinguish the *bonus points* of the present invention from the common understanding of points by characterizing points in the art as business-related and *bonus points* of the present invention as “related to activities” (see at least pp 1 lines 9-10 and 27-30 of the specification), however Examiner interprets purchases as an activity, and thus does not understand Applicants attempted distinction of *bonus points*, Examiner therefore selected prior art that discloses transferring more information than simply transaction related information and interprets *bonus points* broadly to include transaction related points but also personal profile information),
- *receiving and storing said at least one transmitted bonus point based on said identification of said person, whereby, by accessing said bonus points, a personal profile can be generated* (see at least ¶¶0060, information received is transmitted to server 104 and stored, computers 108 are used to access the information for data analysis and profile configuration etcetera).

**Claim 5:**

Albanese, as shown, discloses the following limitation:

- *the bonus point further comprises information relating to the location on which the activity was performed* (see at least ¶0059, “taking into account he

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geographic location of the interaction;" Examiner notes that the data content is non-functional descriptive material and does not lend patentable weight to the claims).

**Claim 6:**

Albanese, as shown, discloses the following limitation:

- *the bonus point further comprises information relating to the time at which the activity was performed* (see at least ¶0059, configurable time delays, inherently if the invention contemplates time delays, then the invention must at least record time to properly implement the pre-configured delay; Examiner notes that the data content is non-functional descriptive material and does not lend patentable weight to the claims).

**Claim 7:**

Albanese, as shown, discloses the following limitation:

- *means for receiving said bonus points based on the activities performed by said person* (see at least ¶0060, any communication s device, item 100 in figure 1),
- *means for transmitting said bonus points together with an identification of said person to a manager server, wherein said manager server is adapted for receiving and storing said bonus points based on said received identification of said person, whereby, by accessing said manager server, said bonus points can be used to generate a personal profile* (see at least ¶0060, any communication s device, item 100 in figure 1).

**Claim 8:**

Albanese, as shown, discloses the following limitation:

- *the collector device is a mobile device* (see at least ¶0060, any communication s device, item 100 in figure 1).

**Claim 9:**



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Albanese, as shown, discloses the following limitation:

- *the collector device further comprises storage means* (see at least ¶0060, any communication s device, item 100 in figure 1, cell phones, smart cards and PDA's have storage means).

**Claim 10:**

Albanese, as shown, discloses the following limitation:

- *means for determining the location on which the activity was performed* (see at least ¶0059, taking into account geographical location, see also at least ¶0074, triangulation).

**Claim 11:**

Albanese, as shown, discloses the following limitation:

- *means for determining the time at which the activity was performed* (see at least ¶0059, configurable time delays, inherently if the invention contemplates time delays, then the invention must at least record time to properly implement the pre-configured delay; Examiner notes that the data content is non-functional descriptive material and does not lend patentable weight to the claims).

**Claim 12:**

Albanese, as shown, discloses the following limitation:

- *the transaction between said collector device to said manager server is given a code being representative to the collector device and the type of activity* (see at least ¶0059, transaction and profile data, Examiner interprets code according to Applicant's disclosure on pp. 8, lines 16-18, where a code is simply more data about the transaction).

**Claim 13:**

Albanese, as shown, discloses the following limitation:

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- *the bonus points are collected locally prior to transmitting the bonus points to the manager server (see at least ¶0060, the device reader receives the data before transmitting to the server, the server may or may not be located local to the device reader).*

**Claim 14:**

Albanese, as shown, discloses the following limitation:

- *an XP- protocol is used to provide the transmission between said collector device and said manager server (see at least ¶0060, any type of communications protocol is suitable).*

**Claim 15:**

Albanese, as shown, discloses the following limitations:

- *means for receiving said bonus points together with an identification of said person from a collector device, wherein said collector device is adapted for receiving and transmitting said bonus points based on the activities performed by said person together with an identification of said person to a manager server (see at least ¶0060, central server)*
- *means for storing said bonus points based on said identification of said person, whereby, by accessing said manager server, said bonus points can be used to generate a personal profile (see at least ¶0059, data stored at the central server is made available to be “mined by a business”).*

**Claim 16:**

Albanese, as shown, discloses the following limitations:

- *a collector device comprising means for receiving said bonus points based on the activities performed by said person (see at least ¶0060, device reader),*
- *means for transmitting said bonus points together with an identification of said person to a manager server (see at least ¶0060, communication lines),*

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- *a manager server comprising means for receiving said bonus points together with an identification of said person from said collector device (see at least ¶0060, central server),*
- *means for storing said bonus points based on said identification of said person (see at least ¶0060, central server)*
- *means for accessing said bonus points based on said identification of said person to obtain a personal profile of said person (see at least ¶0078, master comparing server provides access to the data for analysis and sale to businesses).*

#### **Claim Rejections - 35 USC § 103**

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albanese (U.S. 2004/0111360 A1) in view of **Official Notice**.

#### **Claim 2:**

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Albanese discloses the limitations as shown in the rejection above. Albanese does not specifically disclose batch processing of bonus point data as in the limitation below:

- *prior to transmitting said bonus points relating to said specific activity, the bonus points are collected locally at the collector device and transmitted as a bonus point data package*

However, Examiner takes **Official Notice** that it is old and well known in the art to employ a method of batch processing of data, especially in a situation such as a grocery store or loyalty program, where many terminals are producing multiple data packets for transmission to one central server in a short period of time. Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to rely on a batch processing method for data transmission to reduce demand for server transmission and thereby ensure data is not lost in transmission and that the central server continues to function properly without being clogged with transmission requests.

**Claim 3:**

The combination Albanese/**Official Notice** discloses the limitations as shown in the rejection above. Further Albanese, as shown, discloses the following limitation:

- *transmitting said bonus point data package is performed in predefined time intervals (see at least ¶0059, configurable time delays).*

**Claim 4:**

The combination Albanese/**Official Notice** discloses the limitations as shown in the rejection above. Further Albanese, as shown, discloses the following limitation:

- *the data package comprises bonus points from a number of persons (see at least ¶0059, profile and purchase data is transmitted; Examiner notes that the data content is non-functional descriptive material and does not lend patentable weight to the claims).*

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### **Conclusion**

- 18.** Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
- 19.** Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
- 20.** Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**P.O. Box 1450, Alexandria, VA 22313-1450**

or faxed to **571-273-8300**.

- 21.** Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622  
27 September 2008

/Arthur Duran/  
Primary Examiner, Art Unit 3622